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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/802,797
Filing Date March 9, 2001
Inventorship Whitten et al.
Applicant Microsoft Corp.
Group Art Unit 3714
Examiner Nguyen
Attorney's Docket No. MS-158564.01
Title: "Method and Apparatus for Managing Data in a Gaming System"

REQUEST FOR A PRE-APPEAL REVIEW

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The Pre-Appeal Panel is respectfully requested to consider this Request, which is submitted in accordance with the Pre-Appeal Brief Conference Program rules. Applicant respectfully requests review of the final Office Action dated November 13, 2006.

Claims 18, 20-35, 57-58, 60 and 69-71 are pending. Claims 18, 20-25, 27-35, 57, 58, 60 and 69-71 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,599,194 to Smith et al. in view of Microsoft®Windows98. Claims 26, 32 and 33 stand rejected under § 103(a) over Smith, Microsoft®Windows98 and Links 386 Players.

1 In the final Office Action, the Office maintains its position as articulated in an
2 Office Action dated November 16, 2005. A response to this Office Action was filed
3 on Feb. 15, 2006. Because of the requirements of brevity, Applicant will discuss
4 only the independent claims – claims 18, 22, 27, 57 and 69, and will refer to portions
5 of the response filed on Feb. 15, 2006.

6 Claim 18 recites a game console having features that are described on page 2
7 of the Office Action Response dated Feb. 15, 2006. In making out the rejection of
8 this claim, the Office admits that Smith fails to teach a game console that has a hard
9 disk drive that is configured to store application data such that the data associated
10 with a first application is inaccessible to other applications. The Office then relies on
11 Microsoft®Windows98 for these features and argues that it would have been
12 obvious to utilize the advanced file management techniques taught by
13 Microsoft®Windows98 in Smith “in order to partition a hard disk drive into separate
14 application regions and to make certain files inaccessible to other applications”. (See
15 Office Action dated Nov. 16, 2005, page 7). The Office reasons that the motivation
16 to do so would be to place game data from different video games in a particular
17 location on a hard drive such that game data and application data would be stored on
18 the hard disk in an *organized* manner. In responding to the Office’s rejection,
19 Applicant pointed out that the excerpts of Microsoft®Windows98 relied on by the
20 Office do not teach or suggest a hard disk drive that is configured to store application
21 data such that the data associated with a first application is inaccessible to other
22 applications in a manner contemplated by this claim. (See, Office Action Response
23 dated Feb. 15, 2006, pages 15-16). Applicant further pointed out that the Office used
24 hindsight reconstruction in making its combination. Specifically, Applicant pointed
25 out that Smith deals exclusively with a video game system and the excerpts of

1 Microsoft®Windows98 relied on by the Office deal with a user sharing folders and
2 printers with others on a network. (See, Office Action Response dated Feb. 15,
3 2006, pages 16-17). Applicant noted that Microsoft®Windows98 contemplates
4 giving a user the choice to make folders and printers accessible or inaccessible to
5 others, but that the inaccessibility feature argued by the Office to exist in
6 Microsoft®Windows98 is simply missing. (See, Office Action Response dated Feb.
7 15, 2006, page 17). This being the case, there would simply be no motivation to
8 make the suggested combination. Applicant further contends that the Office's stated
9 motivation is too general. (See, Office Action Response dated Feb. 15, 2006, page
10 17-18; and pages 12-14 for a discussion of the PTO's own paper which discusses
11 proper and improper rejections under § 103). The Office argues that the motivation
12 would be to store data in an *organized* manner. To begin with, Smith does not
13 describe a problem in which its data is stored in an unorganized manner such that it
14 would benefit in any way from Microsoft®Windows98's teachings. Thus, there is
15 no foundation in Smith to support the Office's combination. The Office
16 acknowledges that Smith does not have any such problem. (See Office Action dated
17 Nov. 13, 2006, page 4, para. 8). If Smith does not have any such problem, as the
18 Office admits, why would one look to Microsoft®Windows98 to solve a non-
19 existent problem? The Office argues that the motivation to combine these references
20 is not too general because the problem is a general problem. (See Office Action
21 dated Nov. 13, 2006, page 4, para. 7). The Office further states that "[o]ne is faced
22 with ...the problem of restricting access to certain files or folders from unauthorized
23 programs and games and so limiting access would make the hard disk more
24 organized and prevent alteration of files from unauthorized program." (See Office
25 Action dated Nov. 13, 2006, page 4, para. 7). Again, Smith does not discuss any

1 problem associated with unauthorized access by applications to data. For all of these
2 reasons, this claim and its dependent claims are allowable.

3 In rejecting **claim 22** (the text of which appears on page 3 of the Office
4 Action Response dated Feb. 15, 2006), the Office again relies on the combination of
5 Smith and Microsoft®Windows98, citing to specific sections of Smith that
6 purportedly disclose this claim's subject matter. (See Office Action Response dated
7 Feb. 15, 2006, page 19). Applicant pointed out that these specific sections do not
8 disclose the subject matter that the Office argues is disclosed. (See Office Action
9 Response dated Feb. 15, 2006, pages 19-20). The Office further argues that the
10 combination would be motivated "in order to better organize the files for future use."
11 (See, Office Action dated Nov. 13, 2006, page 5, para. 10). Again, this motivation is
12 too general and Smith does not describe a problem having to do with its organization
13 of files. Accordingly, for at least this reason and the reasons set forth in the Office
14 Action Response dated Feb. 15, 2006, this claim and its dependent claims are
15 allowable.

16 In rejecting **claim 27**, the Office again argues the combination of Smith and
17 Microsoft®Windows98. Applicant pointed out that Smith does not teach preventing
18 a video game from accessing portions of the hard disk drive that are not associated
19 with the video game. (See, Office Action Response dated Feb. 15, 2006, page 21).
20 The Office makes an inherency argument that a game program would inherently not
21 access portions of the hard disk that are not associated with a game. Applicant
22 submits that inherently not accessing portions of the hard disk drive is different from
23 and not to be confused with being prevented from doing so. For this reason and the
24 others set forth in the Office Action Response dated Feb. 15, 2006, this claim and its
25 dependent claims are allowable.

1 In rejecting **claim 57** (whose text can be found on page 7 of the Office Action
2 Response dated Feb. 15, 2006) the Office relies on the combination of Smith and
3 Microsoft®Windows98. For the reasons set forth on pages 22-23 of the Office
4 Action Response dated Feb. 15, 2006, this claim and its dependent claims are
5 allowable.

6 In rejecting **claim 69** (whose text can be found on pages 8-9 of the Office
7 Action Response dated Feb. 15, 2006), the Office again argues the combination of
8 Smith and Microsoft®Windows98. Applicant argued in the Feb. 15, 2006 response
9 that Smith does not disclose a game console in which the processor will not boot
10 without initially loading the initial program read from the fixed disk. Rather,
11 Applicant pointed out that Smith instructs that its system will start under control of a
12 program resident on a cartridge *or* under control of a program resident on the hard
13 disk drive. That is, Smith does not require that a hard disk drive be present to boot
14 the system because Smith can start under the control of a program resident on the
15 cartridge. (See Office Action Response dated Feb. 15, 2006, page 24). For this and
16 for the other reasons set forth with regard to the lack of a prima facie case of
17 obviousness, this claim and its dependent claims are allowable.

18 Applicant respectfully requests reversal of the Office's rejections and
19 forwarding of the application on to issuance.

20 Respectfully Submitted,

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22 Dated: 1/30/07

By 

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